

REMARKS

In a Final Office Action mailed on June 16, 2008, claims 50-58 were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative, as being obvious under 35 U.S.C. § 103(a) over Yamada.

On page 7 of the Final Office Action, the Examiner states that due to the limitations "adapted to," the Examiner has ignored the structural limitations of the claimed device of claim 50. Applicant points out that the Federal Circuit has stated that it is improper to delete functional language from a claim in performing an invalidity determination under § 102. *Pac-tec, Inc. v. Amerace Corp.*, 14 U.S.P.Q.2d. 1871, 1876 (Fed. Cir. 1990), Pac-tec asserted that claims were invalid because the phrase "adapted to" was not a structural limitation. The Federal Circuit expressly labeled as "frivolous" Pac-tec's assertions that the "adapted to" language was improper. The court rejected a construction of claims that eliminated functional limitations so that the claims were reduced to a mere collection of parts. *Id.* That is exactly what the current construction does, as explicitly recited language is being ignored so that a "device" in the abstract is being claimed. However, when the language of claim 50 is assigned the patentable weight that it is due, it becomes clear that claim 50 overcomes the §§ 102 and 103 rejections.

Although Applicant disagrees with the Examiner's construction, to expedite prosecution, Applicant has removed the "adapted to" language from the claim to more positively recite that the device provides a heat demand signal that is indicative of the device needing more thermal energy from a fuel cell. Entry of the amendment is respectfully requested, as the Examiner has already considered these limitations.

As previously pointed out by Applicant, Yamada merely discloses a temperature sensor S21 that merely indicates when a fuel cell unit 7 is behaving abnormally. Yamada, 12:26-32. However, there is no teaching or suggestion in Yamada that the temperature sensor S21 generates a heat demand signal from a device that is thermally coupled by a heat exchanger to a fuel cell to receive thermal energy from the fuel cell. Furthermore, as Yamada fails to explicitly disclose these limitations and thus, fails to anticipate claim 50, the Examiner has provided no plausible reason why one of skill in the art in view of Yamada would have modified Yamada's system to derive the claimed invention.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the

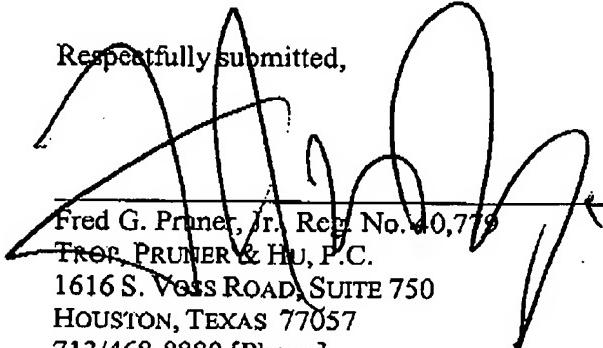
differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

For at least the reason that the Office Action has not identified a reason why one of skill in the art would have derived the claimed invention in view of Yamada, the § 103 rejection of independent claim 50 is defective. Claims 51-58 overcome the §§ 102 and 103 rejections for at least the same reasons as claim 50.

#### CONCLUSION

In view of the foregoing, Applicant respectfully requests withdraw of the §§ 102 and 103 and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (PUG.0083C1US).

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Respectfully submitted,  
  
Fred G. Pruner, Jr. Reg. No. 40,719  
TROP, PRUNER & HU, P.C.  
1616 S. Voss ROAD, SUITE 750  
HOUSTON, TEXAS 77057  
713/468-8880 [Phone]  
713/468-8883 [Fax]